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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,250	12/12/2001	John Ruckart	36968/262329 (BS 001253)	6309
23552	7590	12/03/2003	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			KRAMER, JAMES A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,250

Applicant(s)

RUCKART, JOHN

Examiner

James A. Kramer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 20 recite the limitation "said customized newsletter" in lines 2 and 1, respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences,

Art Unit: 3627

for example) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, mere combining of information and conveying of information while producing a useful result is not within the technological arts and therefore is non-statutory matter. Examiner suggest amending the limitations of claim 1 to include the automated report feature, programmed into the database as disclosed on page 11; line 22 of the specification.

Claims 9-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 10 claims "the operator" in line 2. Applicant cannot claim a person as part of the apparatus claim, as living matter, which is not the result of human intervention, is non-patentable subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Remington et al.

Remington et al. teaches an electronic bill presentment system. The system contains a biller computing unit which creates customized bills in a preferred format. Remington et al. teaches the biller computing unit also including non-billing materials to the bill, such as advertisements or warnings. (e.g. column 8; lines 10-12) (combining billing information and non-billing information to create a customized communication).

Remington et al. further teaches the consumers receive the billing statement electronically via a network (conveying customized communication to a customer electronically).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8 and 12-20, as interpreted by the office are rejected under 35 U.S.C. 103(a) as being unpatentable over Remington et al. in view of Jermyn.

Examiner notes that the biller of Remington et al. (described above) inherently contains a database with customer billing information and non-billing information. This database is necessarily present for the biller to generate the bill (i.e. the biller must store the information for the bill in a database prior to generating the bill).

Remington et al. does not teach:

- Classifying the customers in the database comprising creating a set of classifications that correlate to customer traits and assigning classifications to customers;
- Classifying the non-billing information in the database comprising assigning classifications to non-billing information;
- Combining billing information and non-billing information based on classification matches.

Jermyn teaches a method and apparatus for generating purchase incentive mailings based on prior purchase history. Specifically the system tracks user purchases and then uses this information to generate a customer profile which is stored in a global consumer purchase database (Classifying the customers in the database comprising creating a set of classifications that correlate to customer traits and assigning classifications to customers).

The system then selects a product category and scans the global consumer purchase database to select users that have purchased items with the product category or in a broader category. Examiner notes that the product categories represent the classification of non-billing information.

Finally, the system customizes an incentive for each customer based on the profile of the customer (Combining billing information and non-billing information based on classification matches) and distributes the customize incentive. This “targeted” distribution of incentives is used increase the effectiveness of the promotion of products.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the bill presentment system of Remington et al. by scanning the billing information in the database of Remington et al. in order to select products the user has purchased in the past, then match these products with non-billing information (advertisements) and use the matched non-billing information as part of the bill sent to the user, as taught by Jermyn, in order to increase the effectiveness of the advertisements sent the user.

Remington et al. does not teach sending the customized communication through regular mail channels as a newsletter. Examiner takes Official Notice that is old and well known in the

Art Unit: 3627

art for billers to send bills to user through the mail, in order to reach customers that do not have computer access. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Reminton et al. in view of Jermyn by printing out the customized bill and mailing it to the customer, in order to reach those customers that do not have computer access.

Examiner notes that claims 1-9 are directed to a method of communicating with customers and claims 10-20 are related to the corresponding apparatus for performing the method. As the apparatus claims do not add any limitations beyond those present in the method claims, examiner's rejection of the method claims is hereby applied to the apparatus claim.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

James A. Kramer
Examiner
Art Unit 3627

JAK


Richard Chilcot
Supervisory Patent Examiner
Technology Center 2669
